UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/690,046 | 10/16/2000 | Frederick M.S. Herz | 0635MH-40860 | 1525 |

7590 02/16/2005

| EXAMINER |
|---|
| EDELMAN, BRADLEY E |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2153 | 13 |

Melvin A Hunn
Hill & Hunn LLP
201 Main Street
Suite 1440
Fort Worth, TX 76102

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/690,046 | HERZ ET AL. | |
| | Examiner | Art Unit | |
| | Bradley Edelman | 2153 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *26 January 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

This office action is in response to Applicant's amendment filed on January 26, 2004. Claims 1-10 are presented for examination. Claims 2-10 are new claims.

### *Priority*

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. §120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

The claim of priority filed in this case on January 24, 2000 is not sufficient because it has not included any relationship between the present application and any previously-filed, co-pending application.

### *Specification*

2. The use of various trademarks (i.e. EZ-Pass, LoJack, Amazon.com, etc.) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### *Claim Objections*

3. Claims 2 and 3 are objected to because of the following informalities: In claim 2, on line 8, after the word "profile" the claim appears to be missing the word "and." As it stands, the claim contains a grammatical error. In claim 3, line 5 also contains a grammatical error in the phrase "profile includes travel route history database." Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims all lack a transitional phrase between the preamble and the body. Therefore, it is not clear from the claims whether the claim is "open" or "closed" (i.e. whether the claim is limited to the particular disclosed steps only or whether the claim may include additional steps other than the particular disclosed steps). Language such

as "comprising" or "including" or "consisting of" would clarify which of these interpretations would be appropriate.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding these claims, the language of the claims raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment, or machine which result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. For instance, claim 1 can read on the following:

(a) acquiring location information for a plurality of mobile communicants (i.e. a person yells out to his co-workers "tell me your name, and tell me where you are");

(b) identifying a particular communicant (i.e. the person recognizes a co-worker's voice and name);

(c) accessing a personal profile for said particular mobile communicant (i.e. the person thinks of a request that the co-worker made earlier); and

(d) delivering digital content to said particular mobile communicant based upon preferences identified in said personal profile (i.e. the person hands a piece of paper with numbers on it to the co-worker or speaks a digital number to the co-worker).

Claims 2-10 contain the same type of steps as claim 1 and are thus rejected for the same reasons.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Titmuss et al. (U.S. Patent No. 6,397,040, hereinafter "Titmuss").

In considering all claims, Examiner has interpreted the claims as if they included the transitional phrase "comprising."

In considering claim 1, Titmuss discloses a method of communicating, comprising:

Acquiring location information ("location") for a plurality of mobile communicants ("users"), identifying a particular mobile communicant, accessing a personal profile ("pre-stored preference information") for said particular mobile communicant, and delivering digital content to said particular mobile communicant based upon preferences identified in said personal profile (col. 2, lines 63-67; col. 3, lines 16-22; col. 6, lines 59-62; col. 10, lines 26-49).

7. Claims 1, 4, 5, 9, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Bar et al. (U.S. Patent No. 6,456,852, hereinafter "Bar").

In considering claim 1, Bar discloses a method of communicating, comprising:

Acquiring location information ("location") for a plurality of mobile communicants ("users"), identifying a particular mobile communicant, accessing a personal profile ("personal profile") for said particular mobile communicant, and delivering digital content to said particular mobile communicant based upon preferences identified in said personal profile ("information or advertisements can be provided to the user based on a present location and/or the user's personal profile," col. 5, lines 42-55, col. 6, lines 5-12).

In considering claim 4, Bar discloses a method of communicating, comprising:

Acquiring location information ("location") for a plurality of mobile communicants ("users"), identifying a particular mobile communicant, accessing a personal profile ("personal profile") for said particular mobile communicant, and delivering digital content to said particular mobile communicant based upon preferences identified in said personal profile, wherein said digital content includes combinations of a public information stream and a private information stream ("information or advertisements can be provided to the user based on a present location and/or the user's personal profile," col. 5, lines 42-55, col. 6, lines 5-12, 16-33, wherein digital content can be public traffic or weather conditions, in addition to a private phone call or e-mail).

In considering claim 5, Bar discloses a method of communicating, comprising:

Acquiring location information ("location") for a plurality of mobile communicants ("users"), identifying a particular mobile communicant, accessing a personal profile ("personal profile") for said particular mobile communicant, generating a current trip vector based upon acquired location information ("upon entering a local area"), and delivering digital content to said particular mobile communicant based upon preferences identified in said personal profile and said current trip vector ("information or advertisements can be provided to the user based on a present location and/or the user's personal profile," col. 5, lines 42-55, col. 6, lines 5-12, 16-24).

In considering claim 9, Bar discloses a method of communicating, comprising:

Acquiring location information ("location") for a plurality of mobile communicants ("users"), identifying a particular mobile communicant, accessing a personal profile ("personal profile") for said particular mobile communicant, and delivering road conditions information in the form of digital content to said particular mobile communicant based upon preferences identified in said personal profile ("if a user is interested in local traffic or weather conditions, the server can be configured to automatically place a call to the user upon entering a local area where a traffic or weather advisory is in effect" col. 5, lines 42-55, col. 6, lines 5-12, 16-24).

In considering claim 10, Bar discloses a method of communicating, comprising:

Acquiring location information ("location") for a plurality of mobile communicants ("users"), identifying a particular mobile communicant, accessing a personal profile ("personal profile") for said particular mobile communicant, and delivering digital content, which corresponds to predicted information needs of said particular mobile communicant, to said particular mobile communicant based upon preferences identified in said personal profile ("if a user is interested in local traffic or weather conditions, the server can be configured ot automatically place a call to the user upon entering a local area where a traffic or weather advisory is in effect" col. 5, lines 42-55, col. 6, lines 5-12, 16-24).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bar.

In considering claim 2, claim 2 includes all of the limitations of claim 1 and adds a step of determining a predicted future location of the mobile communicant. Although Bar does not explicitly disclose predicting a future location of the mobile communicant, it does disclose estimating a present location (col. 4, lines 15-18, "determine a location or set of likely locations"). Given this ability to estimate a present location, a person having

ordinary skill in the art would have readily recognized the capability and desirability of additionally predicting a future location, since the mobile user is always moving to a new location. Given this knowledge, it would have been obvious to allow the system of Bar to predict a future location of a user, in order to better tailor the user information to fit the user's expected needs.

In considering claim 3, claim 3 includes all of the limitations of claim 1 and adds a step of accessing a travel route history database, and delivering the content to the user based upon the information in the travel route history database. Although Bar does not explicitly disclose the use of a travel route *history* database, Bar does disclose maintaining a travel route database for at least present locations (apparently, Bar deletes the old locations and replaces them with a current location, col. 4, lines 20-40). Nonetheless, given this ability to maintain a location database, a person having ordinary skill in the art would have readily recognized the capability of additionally maintaining the user's travel route history in order to maintain a log of user's movements. Given this knowledge, it would have been obvious to allow the system of Bar to use the travel route history to affect delivery of the digital content, in order to better tailor the user information to fit the user's needs and desires.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bar, in view of Burns et al. (U.S. Patent No. 5,991,306, hereinafter "Burns").

In considering claim 6, claim 6 includes all of the limitations of claim 1 and adds a step of using conditional probability to identify a plurality of potential future locations for the mobile communicant, and delivering digital content to selected ones of the plurality of potential future locations for pre-caching in memory for future use. Nonetheless, as discussed with regard to claim 2, it would have been obvious to allow the system of Bar to predict a future location of a user, in order to better tailor the user information to fit the user's expected needs. In addition, it is well-known to pre-cache data for future use by service providers in a data delivery system, as evidenced by Burns (col. 4, lines 25-37). Given this knowledge, a person having ordinary skill in the art would have readily recognized the desirability and advantages of pre-caching desired information, as taught by Burns, for the future locations suggested by Bar, in order to save memory space and better optimize data delivery of the system (see Burns, col. 4, lines 39-45). Therefore, it would have been obvious to predict the future locations of the mobile communicant and to pre-cache information on those locations, as suggested by the combined teaching of Bar and Burns.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bar, in view of Merriman et al. (U.S. Patent No. 5,948,061, hereinafter "Merriman").

In considering claim 7, claim 7 includes all of the limitations of claim 1 and adds a step of utilizing autonomous user-side agents to negotiate terms and conditions for the receipt of advertisements, and delivering the digital content based in part on the negotiated terms and conditions. Bar further discloses negotiating terms and conditions

for receiving advertisements and delivering the digital content based on the terms and conditions (col. 6, lines 5-12). However, Bar remains silent regarding how the terms and conditions are negotiated (Bar just assumes they're already stored in the user's profile). Nonetheless, it is well known to negotiate advertisements based on autonomous user-side agents (i.e. cookies), as evidenced by Merriman (col. 3, lines 41-56). Given this teaching, it would have been obvious to a person having ordinary skill in the art to enter the negotiated terms and conditions taught by Bar using automated agents, to avoid the need for a user to physically sign up and select preferred advertisements.

11. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bar, in view of what was commonly known in the art at the time of invention.

In considering claim 8, claim 8 includes all of the limitations of claim 1 and adds a step of acquiring sensor data from a vehicle associated with said particular mobile communicator. Bar further suggests the notion of associating a vehicle with the particular mobile communicator (i.e. delivers traffic information to the mobile device when the mobile user enters the traffic area). Furthermore, Examiner takes official notice that it is well known to acquire sensor data from a vehicle associated with a particular mobile communicant (i.e. it is well known for a driver associated with a vehicle to read acquired sensor data from the vehicle, such as speed, oil pressure, engine heat, gas tank level, miles traveled, etc.). Given this knowledge, a person having ordinary skill in the art would have readily recognized the desirability and advantages of using

the mobile device taught by Bar in a car that acquires sensor data so that the user can find his/her way to his/her destination without running out of gas or getting pulled over for speeding. Therefore, it would have been obvious to include the step of acquiring sensor data from a vehicle associated with the mobile communicant in the system taught by Bar.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is 571-272-3953. The examiner can normally be reached from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached at 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bradley Edelman

BE
February 15, 2005